

### **REMARKS/ARGUMENTS**

Applicant would like to thank the Examiner for the careful consideration given the present application. The application has been carefully reviewed in light of the Office Action, and amended as necessary to more clearly and particularly describe and claim the subject matter which applicants regard as the invention.

Claims 1–38 remain in this application. Claims 25-38 have been indicated as being in a condition for allowance.

Claims 1–2 and 13–14 were again under 35 U.S.C. §103(a) as being unpatentable over Malkemes *et al.* (WO 97/40584) in view of Igarashi *et al.* (U.S. 5,926,749) and further in view of Nguyen (U.S. 6,253,092). For the following reasons, the rejections are respectfully traversed.

Claims 1 and 13 have been amended to recite that said plurality of amplifiers comprise an “amplifier unit.” None of the prior art references show any amplifier unit that includes a plurality of power amplifiers for “variably amplifying the transmission signal modulated by the modulator for transmission without further modulation.” The Examiner confirmed this observation in the personal interview conducted on December 13, 2005. Accordingly, claims 1 and 13 are patentable over the references.

Claim 2, which depends on claim 1, and claim 14, which depends on claim 13, are thus patentable over the references for at least the same reasons as the parent claims, as are new claims 39 and 40.

Furthermore, new claim 39 recites that said plurality of amplifiers comprise an “amplifier unit” and that “said plurality of variable power amplifiers are individually controlled such that a function of an output of said amplifier unit to a control voltage is substantially linear over a wider range of said control voltage than is a function of each one of said

plurality of variable power amplifiers to said control voltage." New claim 40 has been added to recite similar language for dependence upon claim 13.

None of the prior art references teach an amplifier unit comprised of a plurality of variable power amplifiers with the cited characteristics. Thus, claims 39 and 40 are patentable over the references.

Claims 7 and 19 under 35 U.S.C. §103(a) as being unpatentable over Malkemes in view of Fujita (EP 888,250 A2). For the following reasons, the rejection is respectfully traversed.

First, the Examiner states in the first paragraph of the Office Action that the rejection of claim 7 has been withdrawn, stating that previous arguments were persuasive. However, the Examiner repeats the previous rejection of claim 7 on page 4 of the Office Action. Accordingly, applicant does not understand the status of claim 7.

Furthermore, claim 7 recites the step of "controlling, using said plurality of voltage controllers, a *power amplifier* for amplifying a transmission signal via *separate bias systems*." Claim 19 also recites an amplifier having "separate bias systems." The Examiner cites Fujita as teaching such a limitation, but as was pointed out to the Examiner at the interview, it is clear that there is no *amplifier* shown in Figure 4 of Fujita has separate bias systems. Instead, bias system 24 of Fujita is connected to amplifier 3, whereas bias system 25 is connected to amplifier 5. Similarly, controller 7A is connected to amplifier 1, whereas controller 26, although not connected to any amplifier, is connected to items 24 and 25, which are connected to amplifiers 3 and 4, respectively. It was particularly pointed out that there is no single amplifier being controlled by a *plurality* of controllers, in contrast to the example shown in Fig. 11 of the application by items 13, 19 and 20, which show a single amplifier (13) controlled by two voltage controllers (19, 20). This is supported by the claim

language which clearly specifies that at least one amplifier have *multiple* controllers, which is *not* suggested by any of the references.

The Examiner agreed at that interview that the cited reference does not appear to teach the cited claim language, and agreed that the rejection should be withdrawn and a new search conducted, but this has not been done.

Furthermore, applicant does not understand the Examiner's statements on page 5 of the Office Action, where the Examiner states that she considers the term "amplifier" as being a "general term in the invention referring to the 'variable amplifier'." Whether or not that is the case, the prior art does *not* show any *amplifier* having separate bias systems, as specifically recited in the claim.

Accordingly, claims 7 and 19 are patentable over the references. The remaining claims, which depend on one of the above discussed independent claims, are patentable over the references for at least the same reasons as the parent claims

Finally, the Examiner has failed to provide the proper motivation for combining the references. The Examiner states, for example, that the motivation for modifying Melkemes using Igarashi is to "provide an amplifier circuit suitable for a transmitter, which is capable of realizing a large dynamic range in a simple configuration." However, this is not a proper motivation, as it is merely a generalized benefit that could support many different solutions.

The Examiner must provide a motivation for modifying the primary reference. Merely listing an advantage found in the secondary reference is not legally sufficient motivation, because this would make *any* secondary reference self-motivating for *any* primary reference, because every reference teaches some advantage that the Examiner could then cite. To make this legally sufficient motivation would mean that no new combinations of known features would be patentable, and this is clearly not the law.

To support a prima facie case of obviousness, the Examiner must show that there is some *suggestion* or *motivation* to specifically modify the reference (MPEP §2143.01). The mere fact that references *can* be combined or modified, alone, is not sufficient to establish prima facie obviousness (*Id.*). The prior art must also suggest the *desirability* of the specific combination (*Id.*). The fact that the claimed invention is within the *capabilities* of one of ordinary skill in the art is not sufficient, by itself, to establish prima facie obviousness (*Id.*).

The motivations provided for the various other rejections are similarly deficient. Accordingly, the rejections for obviousness is not proper, and should be withdrawn.

In consideration of the foregoing analysis, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the Examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No. 33677.

Respectfully submitted,

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Date: July 7, 2006